

The opinion in support of the decision being entered today was
not written for publication and is not binding
precedent of the Board

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS ELLIOT RABE,
HELEN SHU YING YEN,
JUNE TURKANIS BRENNOCK and
CAROLINE BECQUE MARTELLO

Appeal No. 2004-1386
Application 09/629,734

ON BRIEF

Before ADAMS, MILLS, and PAWLIKOWSKI, Administrative Patent
Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
examiner's final rejection of claims 1-7, and 10-21.

Claim 1 is representative of the subject matter on appeal,
and is set forth below:

1. A method of topically applying a topical emulsion
composition comprising electrostatically spraying an emulsion
composition onto the skin, wherein the emulsion comprises:

- (a) from about 5% to about 75% of an insulating external
phase comprising one or more liquid insulating materials; and
- (b) from about 15% to about 80% of a conductive internal
phase comprising one or more conductive materials.

Appeal No. 2004-1386
Application No. 09/629,734

On page 2 of the brief, appellants state that the claims stand or fall together. We therefore consider claim 1 in this appeal. 37 CFR §1.192(c)(7) and (8) (2003).

Claims 1-7 and 10-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barnett in view of Masuda.

The examiner relies upon the following references as evidence of unpatentability:

Barnett et al. (Barnett)	5,494,674	Feb. 27, 1996
Masuda	WO 98/26752	June 25, 1998

OPINION

Barnett is directed to a system for delivering skin treatment agents directly to the skin. Such agents are applied onto the skin using the principle of electrostatic spraying. See column 1, lines 5-10. Skin treatment agents which may be delivered using the system of Barnett "can be any of a very wide range of materials, preferably any of those skin treatment materials already known for use in conventional massage or rub-in lotions or cream products." See column 3, lines 63-68. Specific examples of suitable skin treatment actives are set forth in column 4, lines 4-38. Also, Barnett teaches that the composition comprises a solvent. Suitable solvents include "alcohols or polyols such as ethanol, isopropyl alcohol, . . .". See column 4, lines 50-54. We note that these components are the same components that appellants disclose on page 8 of the specification as materials for claimed component (b). Hence, Barnett teaches claimed component (b).

Barnett also teaches that depending upon the composition or material to be delivered, it may be necessary to adjust its resistivity by addition of one or more resistivity adjusting materials, examples and suitable amounts of which will be either known to persons skilled in the art, or readily derivable by simple experiment. See column 5, lines 24-30. To lower the resistivity of the composition, polar substances, such as alcohols, specifically, ethanol, may be used. To increase resistivity of the composition, non-polar substances, such as oils, and other hydrophobic materials, may be used. See column 5, lines 30-36 of Barnett.

With regard to the claimed "insulating external phase" (component (a)), appellants' specification, on page 6, beginning at line 23, discloses suitable materials. These materials can be "selected from non-polar substances, e.g., oils and other hydrophobic materials". See page 6, lines 23-25 of the specification. These are the same substances as described in Barnett at column 5, lines 31-33. Barnett teaches that the particular amount to be selected "will be either known to persons skilled in the art, or readily derivable by simple experiment." See column 5, lines 25-29. Adding these oils or other hydrophobic materials to the composition of Barnett (as described on page 2 of this brief) would be a mixture of appellants' claimed component (a) and (b).

As a further teaching, we refer to column 8, lines 40-44 of Barnett. Here, Barnett teaches a composition comprising **(1)** 65 % DC344 (appellants' claimed component (a); see page 7, lines 1-15 of appellants' specification), and **(2)** 30% ethanol (appellants' claimed component (b)), in amounts within appellants' claimed percentage ranges, respectively. Electrostatic spraying of this composition is conducted. See column 9, lines 1-10 of Barnett.

On page 3 of the brief, appellants argue that Barnett does

Appeal No. 2004-1386
Application No. 09/629,734

not suggest spraying an emulsion composition. Appellants argue that Barnett teaches away from more complex composition like emulsions and refers to column 1, lines 26-31 of Barnett. However, as stated by the examiner on page 4 of the answer, Barnett teaches actives miscible with a solvent, and such a mixture would form an emulsion. We agree. As discussed above, Barnett mixes the same kinds of ingredients as set forth in appellants' specification (which appellants state form an emulsion).

In view of the above, we determine that the examiner has set forth a prima facie case of obviousness.

We need not discuss the Masuda reference in light of the teachings of Barnett, with regard to appellants' claim 1, which is the only claim under consideration in this appeal and the only claim argued by appellants. Also, as stated, supra, appellants have grouped the other claims with claim 1. Compare, In re Watts, 354 F.3d 1362, 1369, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004). The examiner relies upon Masuda for certain dependent claims which are not under consideration in this appeal.

CONCLUSION

The 35 U.S.C. § 103 rejection of claims 1-7 and 10-21 is affirmed.

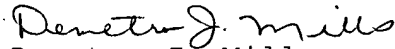
Appeal No. 2004-1386
Application No. 09/629,734

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



Donald E. Adams)
Administrative Patent Judge)



Demetra J. Mills)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES



Beverly A. Pawlikowski)
Administrative Patent Judge)

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Appeal No. 2004-1386
Application No. 09/629,734

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